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In re Application of : DECISION ON PETITION
JOHNSON, et al. :
U.S. Application No.: 09/762,077 :
PCT No.: PCT/US99/17338 : UNDER 37 CFR 1.47(a)
Int. Filing Date: 30 July 1999 :
Priority Date: 30 July 1998 :
Attorney Docket No.: 56326-032 (IOPL-007) :
For: INFARED RADIATION SOURCES, SENSORS :
AND SOURCE COMBINATIONS, AND :
METHODS OF MANUFACTURE :
:

This decision is in response to applicants' "PETITION UNDER 37 CFR § 1.47(a)" filed 08 August 2001.

BACKGROUND

On 30 July 1999, applicants filed international application PCT/US99/17338, which claimed priority of an earlier application filed 30 July 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 29 February 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 January 2001.

On 30 January 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the International Search Report and a copy of the International Preliminary Examination Report. An oath or declaration of the inventors was not included.

On 08 March 2001, applicants were mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicants were advised of the need to respond within one month or by 31 months of the priority date whichever was later and that this time period could be extended with a proper petition and payment of fees.

On 08 August 2001, applicants responded with the present petition to accept the present

oath or declaration without the signature of joint inventor W. Andrew Bodkin accompanied by a combined declaration and power of attorney executed by all the remaining joint inventors other than Mr. Bodkin and a petition for a four-month extension of time. With the filing of the petition for a four-month extension of time and payment of the extension of time fee, applicants' petition is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1), applicants have provided the \$130.00 petition fee under 37 CFR 1.17(I) along with the present petition.

Regarding Item (3), applicants have provided the last known address of Mr. Bodkin. Accordingly, Items (1) and (3) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." In the present petition, applicants claim that Mr. Bodkin refuses to execute the oath or declaration. However, it is unclear whether Mr. Bodkin has been presented with a complete copy of the application papers as required. The declaration of Edward A. Johnson seems to imply that Mr. Bodkin was merely sent a copy of the declaration and not a complete set of application papers. This is insufficient. In addition, the nature of the purported refusal is unclear. Mr. Johnson states that, "I was informed that Mr. Bodkin had received the inventors' declaration for his signature but that Mr. Bodkin refused to sign..." It is unclear whether the refusal came directly from Mr. Bodkin and that Mr. Johnson heard the refusal.

Regarding Item (4), the accompanying declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor contains two "Page 4 of 4." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

In light of the above, applicants' petition can not be granted at this time. It is necessary to

provide copies of the receipts of mailing be it certified mail receipts or Express Mail receipts which show Mr. Bodkin's address and dates of attempted delivery. It must be shown that inventor Bodkin was provided a complete set of the application papers and either expressly refused to sign the declaration or did not respond. Any statements of facts concerning the attempts to obtain Mr. Bodkin's signature and his subsequent refusal must be made by persons having first hand knowledge of those facts.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice.**

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.



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